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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/926,130	09/07/2001	Toru Nakamura	213151US0PCT	7782

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

13
EXAMINER

ZIMMER, MARC S

ART UNIT	PAPER NUMBER
1712	

DATE MAILED: 07/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 09/926,130	Applicant(s) NAKAMURA ET AL.	
	Examiner Marc S. Zimmer	Art Unit 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on 23 May 2003.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 14-20 and 22 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 14-20 and 22 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

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Priority under 35 U.S.C. §§ 119 and 120

13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☒ All b) ☐ Some * c) ☐ None of:

1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.

4) ☐ Interview Summary (PTO-413) Paper No(s). _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14-20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boardman et al., U.S. patent # 6,046,250.

In paper no. 11, the Examiner indicated that claims 14-20 and 22 were allowable because the reference, "does not suggest that the base silicone polymer may be comprised of *two or more* silicones having distinct substitution patterns. However, it is presently appreciated that claim 14 not only contemplates layers comprising vinyl-functional polyorganosiloxane/hexenyl-functional polyorganosiloxane mixtures, but also layers derived from hexenyl-substituted silicones alone. Hexenyl group-functionalized silicones are explicitly taught in column 7, lines 20-51 hence claim 14, like presently cancelled claim 7, is obvious in view of the reference as claim 14 mirrors claim 7 in every respect with the exception that a specific substitution pattern is mandated of the silicone in claim 14. That is, the same rationale that had been applied to claim 7 in paper no. 11 is relevant here also. This error is sincerely regretted.

Claims 15, 17, 18, 19, and 20 further limit claim 14 in the same manner as 10, 8, 11, 12, and 13 respectively limited claim 7 and, therefore, are rejected for the same reasons set forth in paper no. 11.

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As for claim 16, polyethylene terephthalate is the substrate of interest in Example 5.

As for claim 22, in Example 5, the silicone layer is first subjected to irradiation using a mercury lamp. Thereafter, it is heated in a circulating oven at 100° C for five minutes. This process contrasts from that which is claimed in that the curing treatments are performed in reverse order. However, it is unlikely that this would yield a different product. *In arguendo*, claims 22 does not stipulate that these steps are to be carried out in a specified order. Ultimately, the significant aspect that the silicone is cured, at least in part, by irradiation with ultraviolet light is satisfied.

Allowable Subject Matter

The embodiment wherein the polymer matrix is a mixture of vinyl- and hexenyl-substituted polysiloxane disclosed in claim 14 is still considered allowable over the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 703-605-1176. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on 703-308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

July 1, 2003

A handwritten signature in cursive script, reading "Robert A. Dawson".

Robert Dawson
Supervisory Patent Examiner
Technology Center 1700

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